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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,222	09/25/2006	Theophil Markus Lutz	930024-2031	6514

7590 12/19/2008
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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12/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,222	Applicant(s) LUTZ ET AL.	
	Examiner Anthony J. Green	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/02/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment submitted on 02 October 2008. Claim 17 has been canceled. Accordingly claims 14-16 and 18-27 are currently pending in the application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-16 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (US Patent No. 2005/0258401 A1) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the instant claims are not rendered obvious by the reference as the specification clearly states that lithium glycerophosphate has a much greater penetrability into concrete than sodium glycerophosphate and that applicant has recently conducted a series of tests to demonstrate that lithium glycerophosphate has a much greater penetrability into concrete than sodium glycerophosphate.

To these arguments the examiner respectfully disagrees. The specification only compares lithium glycerophosphate with sodium monofluorophosphate and thus is not a proper comparison. As for applicant's arguments that a series of tests were performed

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to show unexpected results it should be noted that providing test results in the response is not a proper showing. That is, a proper showing would be a declaration which clearly shows the unexpected results. Accordingly until such time that a proper showing of unexpected results is presented the rejection is not overcome and therefore maintained by the examiner.

4. Claims 14-16 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (US Patent No. 2005/0258401 A1) in view of Ray (US Patent No. 4,098,614 A) for the reasons set forth in the previous office action and which are herein incorporated by reference.

Applicant argues that the secondary reference does not teach the equivalency of the lithium and sodium salts but the equivalency of the magnesium, potassium and sodium salts and the premium ranking position of the calcium salt. In other words it teaches away from the use of lithium salt and urges those skilled in the art to use the calcium salt. Also applicant argues that the secondary reference teaches the use of the salts for obtaining a short-term effect whereas the present invention relates to long-term anticorrosion protection of the rebars and therefore it would not be obvious to utilize a teaching of short term strength increase to a long term anticorrosion protection.

Applicant also argues that the secondary reference does not teach the use of the composition for treating steel rebars. Further the experimental results provided above clearly demonstrate the Li salt and Na salt are not equivalent.

To these arguments the examiner respectfully disagrees. While the secondary reference teaches that calcium salt is preferred it does teach that lithium may be utilized and accordingly it would have been obvious to utilize lithium salt since it is suggested by the disclosure of the use an alkali metal salts. As for the arguments concerning the short term strength increase and long term anticorrosion protection it is the position of the examiner that the substitution of lithium salt for the salt of the reference would result in the same composition and if the composition is physically the same, it must have the same properties absent a showing otherwise. With respect to applicant's arguments concerning the fact that the secondary reference does not teach the use of the composition for compositions containing rebars it should be noted that the reference is relied on to show that various alkaline earth metal and alkali metal glycerophosphates may be used in cement composition. As for applicant's arguments that a series of tests were performed to show unexpected results it should be noted that providing test results in the response is not a proper showing. That is, a proper showing would be a declaration which clearly shows the unexpected results. Accordingly until such time that a proper showing of unexpected results is presented the rejection is not overcome and therefore maintained by the examiner.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony J. Green/

Primary Examiner
Art Unit 1793

ajg
December 8, 2008